

FARKAS & MANELLI PLLC
ATTORNEYS

February 28, 2000

VIA HAND-DELIVERY

Ms. Esther Kepplinger
Director of Group 1700
United States Patent & Trademark Office
Washington, D.C. 20231

Re: Improper Withdrawal From Issuance of
U.S. Patent Application Ser. No. 09/009,294

Dear Ms. Kepplinger:

This letter is a follow-up to our telephone conversations of last week concerning recent actions taken by the U.S. Patent and Trademark Office, which, as indicated in the attached February 17, 2000 Notice from the Office of Petitions, has resulted in the withdrawal from issuance of Patent Application Ser. No. 09/009,294. This application was due to issue as U.S. Patent No. 6,030,601 on February 29, 2000.

As I understand it, these actions were based on U.S. Patent Office concerns that the technology developed by inventor Dr. Randell L. Mills and disclosed in the subject patent application, and perhaps in other allowed applications and a prior issued patent of Mills, represents "unproven science," such as "cold fusion." I am writing to allay those concerns and to assure you that they are unfounded inasmuch as this technology has been subject to extensive testing and proven beyond argument to work. The results of that testing have already been presented and positively considered by the U.S. Patent Office and embraced by highly reputable companies, not to mention the U.S. Navy and the American Chemical Society.

Before proceeding any further, let me just say that I appreciate the courtesy you extended in taking my calls inquiring into this matter and the circumstances surrounding this rather unusual turn of events. I gathered from your comments that you share my desire to resolve this matter as directly and expeditiously as possible, and it is my sincere hope that this letter, as the first step in that process, will convince you that there is no need for further examination of the '294 patent application and that it should be immediately allowed to issue.

As I stated during our conversations, this application, as well as the other allowed Mills applications assigned to my client, Blacklight Power Inc., represents a significant advance in the

chemical arts. The underlying technology disclosed in these applications is the culmination of over ten years of research and the expenditure of over ten million dollars invested by well-known companies, such as AMP Corporation, Connectiv, and PacificCorp, companies that would not dare risk their business reputations on "unproven science."

To be sure, Dr. Mills' technology has undergone rigorous testing by over 25 well-known independent laboratories and has been shown to be based on sound scientific principles and, more importantly, shown to work precisely as described in Mills' '294 patent application. Based on his startling discoveries, Dr. Mills was bestowed the honor of addressing the October 1999 meeting of the American Chemical Society (ACS) in California, during which he presented to an enthusiastic and receptive audience the test results for the very compounds disclosed and claimed in that application. Also a featured speaker at this meeting was Dr. Johannes Conrads, retired Director and Chairman of the Board of the Institute for Low Temperature Plasma Physics at Ernst Moritz Arndt University in Greifswald, Germany. Dr. Conrads, considered by many to be one of Germany's top physicists, tested the Mills technology himself and reported to the ACS that it produced an energetic plasma in hydrogen with no power input, conclusively demonstrating a new source of chemical energy from hydrogen never before seen. Dr. Conrads, and the four other top scientists who assisted in this testing, would not put their professional reputations in jeopardy for the sake of "unproven science."

These positive test results also have not escaped the attention of the U.S. Government. Following a thorough review, the United States Navy has taken affirmative steps to develop applications based on the Mills technology in cooperation with Blacklight Power.

In view of the allowance of this and other patent applications of Dr. Mills, the issuance of U.S. patent No. 6,024,935 to Dr. Mills, and other highly-desirable commercial applications of the Mills technology, Blacklight Power's management has committed to the process of going public and has limited its choice of underwriter to either Morgan Stanley or Goldman Sachs, two of Wall Street's top investment firms who also share an interest in carefully guarding their business reputations. Indeed, this process is now in the latter stages, with the filing statement for the IPO scheduled for late March. The market capitalization for this public offering is expected to exceed one billion dollars based on current market conditions. Blacklight Power's current private market capitalization is already in excess of 340 million dollars, based on the last private placement that was oversubscribed.

This enthusiastic public response to Blacklight Power and the revolutionary technology it developed did not just happen by chance. The company has been built upon a rock solid foundation of top-notch scientists and leaders in chemistry and physics. Included among the distinguished board members of Blacklight Power are: Dr. Shelby T. Brewer, M.S. and PhD. degrees from MIT in Nuclear Engineering, former Assistant Secretary of the Department of Energy and former Chief Executive Officer of Combustion Engineering's Nuclear Business; George A. Sawyer, former Assistant Secretary of the Department of Navy; David Blake presently with Connectiv and formerly a top manager with Du Pont and Hercules Chemical Specialties

Company; and Michael P. Kalleres, former President and CEO of Global Associates, Ltd., Technology Services Group, and retired Vice Admiral from the U.S. Navy, currently serving on the Defense Science Board, the Naval Studies Board of National Academy of Science, and the Dean's Advisory Council of Purdue University. Furthermore, many of the shareholders of Blacklight Power are Phd. chemists and physicists. Certainly, the U.S. Patent Office does not believe that this impressive list of Phd. chemists and physicists associated with Blacklight Power would waste their money and efforts on "unproven science."

No doubt, therefore, you can appreciate the significant negative impact the PTO's withdrawal of the '294 patent application from issuance has had not only on Blacklight Power, but on many other players in the industry, including the U.S. Government, who have a vested interest in seeing that the Mills technology is not just commercially developed, but also adequately protected against piracy. Thus, you can understand my utter dismay when you informed me that this application had been "pulled" based on some perceived "heat" (from an undisclosed source) without reviewing the file history. As with any revolutionary technology, such negative reactions should not be surprising and, indeed, should be expected. I would hope that the Patent Office would not act "willy-nilly" upon some unfounded conclusions drawn without adequate evidentiary basis.

I was also disturbed by Director Robert Spar's comment to me that he directed Petitions Examiner Frances Hicks to issue the petition to withdraw the subject patent application from issuance based on the premise that the underlying technology involved "cold fusion." With all due respect, that assertion is baseless and utter nonsense since the subject patent application is directed to chemical compositions of stable matter rather than a nuclear reaction process. The distinction between stable chemical compounds and a nuclear reaction process should be obvious to any competent chemist and such a determination was in fact made by the U.S. Patent Office.

One such competent chemist, Primary Examiner Steven Kalafut, evaluated over 130 published "cold fusion" articles during prosecution of the subject patent application, as evidenced by the extensive initialed Form PTO/SB/08A and B documents, and it was certainly clear to him that the subject application is not related to cold fusion. Examiner Kalafut was advised by the undersigned during a personal interview that these immaterial "cold fusion" publications were being submitted in the subject application only because they were previously cited by Examiner Harvey Behrend of Group 3641 in an earlier application by Dr. Mills. Steven Kalafut also withdrew a Section 101 rejection of the subject application based on inoperability after Dr. Mills personally submitted convincing experimental evidence by unbiased third party physicists and chemists that the subject patent application is operable.

Another competent chemist, Primary Examiner Wayne Langel, also examined the over 130 published "cold fusion" articles during prosecution of another patent application and allowed that application to issue as U.S. Patent No. 6,024,935. Examiner Langel was also advised by the undersigned during a personal interview that these immaterial "cold fusion" publications were

being submitted only because they were previously cited by Examiner Harvey Behrend of Group 3641 in an earlier application by Dr. Mills.

The '935 patent, prior to issuance, is believed to have been subject to another level of review and approved by the Office of Patent Quality Review. This belief is based on the fact that the application was sent back to Examiner Langel to correct a very minor mistake in claim 304, line 1 to replace "304" with - - 303 - - after the application was forwarded to the Patent Publication Branch. Furthermore, the patent issued more than ten months after payment of the issue fee, allowing more than sufficient time for U.S. Patent Office to review the '935 patent before issuance.

I must say that I was also somewhat taken aback by your statement that you had no evidence that the invention disclosed in the subject '294 application was inoperable. In spite of this lack of evidence, you also stated that you believed the invention was inoperable because you learned in a textbook that "atomic hydrogen" cannot go below the "ground state." We acknowledge that atomic hydrogen having the ground state of 13.6 eV can only exist in a vacuum or in isolation, and that atomic hydrogen cannot go below this ground state in isolation. However, please keep in mind that there is no known composition of matter containing hydrogen in the ground state of 13.6 eV. When hydrogen reacts with another element, it goes to a lower energy state. Dr. Mills has discovered new compositions of matter containing hydrogen at new lower energy levels, which lower energy levels are achieved using the novel catalysts disclosed in the subject patent application. Over forty new compounds have been produced using Dr. Mills technology which exhibit novel, commercially valuable properties. The existence of the new lower energy level hydrogen has been established by well known analytical chemistry methods including Nuclear Magnetic Resonance Spectroscopy, Time of Flight Secondary Ion Mass Spectroscopy, and X-Ray Photoelectron Spectroscopy conducted by unbiased third parties. Primary Examiners Kalafut and Langel have fully evaluated this extensive experimental data.

To distinguish the new lower energy level hydrogen from conventional energy level hydrogen, Dr. Mills has named the new lower energy level hydrogen "hydrinos." "Hydrino" is latin for smaller or tighter bound hydrogen. The subject patent application describes and claims novel chemical compositions of matter comprising hydrinos. Please be assured that absolutely no nuclear "cold fusion" reactions are occurring in the formation of the hydrinos.

The U.S. patent system worked precisely as intended in the issuance of U.S. Patent No. 6,024,935 and the Notice of Allowances in five U.S. patent applications of Dr. Mills, including the subject application. The issued '935 patent and the five allowed patent applications were objectively and fairly examined by experienced Primary Examiners Kalafut and Langel on all of the surrounding facts, including "cold fusion" accusations. When I inquired about the '935 patent and these other allowed applications, Director Spar also informed me that the '935 patent will most likely be Reexamined by the U.S. Patent Office and petitions for withdrawal from issuance will be filed in the other four allowed applications of Dr. Mills. To overturn the objective examination of these applications by two experienced, chemical Primary Examiners

Ms. Esther Kepplinger, Dir. 1700
February 28, 2000
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based on a whim and unsubstantiated "cold fusion" accusations by unnamed parties undermines the integrity of the U.S. Patent Office and, indeed, the entire U. S. patent system.

In an effort to better understand the underlying basis for the PTO's actions and to bring this matter to a swift conclusion, we respectfully request a meeting with you and whoever else you deem to be appropriate, to discuss this matter further before any Office Actions are issued in the subject '294 patent application or in any other presently allowed application, and before any Reexamination of the '935 patent that would drag this matter out before the public.

Since the U.S. Patent Office was unable to locate a copy of the prosecution history for the subject patent application as of February 25, 2000, more than one week after Ms. Hicks signed the petition, we have enclosed a courtesy copy of our prosecution file history for your review in this matter.

Thank you for your attention to this matter and we look forward to your prompt reply.

Sincerely yours.



Jeffrey S. Melcher
Reg. No. 35,950
Tel. No.: 202.261.1045

Attachments

Cc: The Honorable Todd Dickinson - Commissioner of Patents
Robert Spar - Director of Special Programs
Francis Hicks - Petitions Examiner
Stephen Kalafut - Primary Examiner Group 1700
Wayne Langel - Primary Examiner Group 1700



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

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**SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS**

NOTICE

In re Application of
Randell L. Mills
Application No. 09/009,294
Filed: January 20, 1998
Attorney Docket No. 911319

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The purpose of this communication is to inform you that the instant application, which has received Patent No. 6,030,601 and an issue date of February 29, 2000, is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn to permit reopening of prosecution. This withdrawal was requested by the Director, Special Program Law Office.

The issue fee is refundable upon written request. However, if the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

This application, upon receipt in the Office of Petitions, will be forwarded to Technology Center AU 1745 for reopening of prosecution.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-8680.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects



Eric

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SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

In re Application of
Mills et al.
Application No. 09/009,294
Filed: January 20, 1998
For: HYDRIDE COMPOUNDS

DECISION ON PETITION

This is in response to three communications submitted on February 28, 2000, regarding the application No. 09/009,294, requesting that the Commissioner review the action of the Director, Special Programs Law Office, with respect to the withdrawal of this application from issue. Although the three letters fail to clearly identify the submissions as a formal petition under 37 CFR 1.181 requesting the Commissioner to invoke his supervisory authority, the submissions are being treated as a single petition under 37 CFR 1.181(a)(3). The three letters are: (1) a February 28, 2000, letter to the Commissioner; (2) a February 28, 2000, letter to Director Spar; and (3) a February 28, 2000, letter to Director Kepplinger.

The petition is denied.¹

BACKGROUND

A Notice of Allowance and Issue Fee due was mailed in the above-identified application October 18, 1999, which set a statutory period of three months to pay the issue fee.

On October 22, 1999, the PTO processed applicant's issue fee payment, and the application in due course was assigned a patent No. (6,030,601) and an issue date of February 29, 2000.

On February 15, 2000, U.S. Patent No. 6,024,935 (the '935 patent), titled "Lower Energy Hydrogen Methods and Structures," issued to the assignee Blacklight Power, Inc., which patent named Randell Mills et al. as the inventors.

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.



On February 17, 2000, the Director of the Technology Center (Director) which had examined the application that issued as the '935 patent, learned that the '935 patent had issued.

Shortly thereafter, upon inspecting the '935 patent, the Director read, *inter alia*, that the invention therein was asserted to relate to the discovery that energy was released by stimulating hydrogen atoms to relax, and, in so doing, to shrink to smaller radii, and to also attain energy levels below their "ground state" according to a "novel atomic model." The Director was immediately struck by the assertion that the electron of a hydrogen atom could attain an energy level and orbit below the "ground state" corresponding to a fractional quantum number because such an assertion did not conform to the known laws of physics and chemistry. The Director was immediately aware that any pending application embodying such a concept raise a substantial question of patentability of one or more claims which would require reopening prosecution.

The Director further became aware that another pending application that embraced the above-noted contradiction to the known laws of chemistry and physics, was application 09/009,294 and that application was scheduled to issue as a patent on February 29, 2000.

In response to a request for prompt assistance from the Director in ensuring that the patent would not issue, the Director, Special Programs Law Office (SPLO) requested that the above-identified application be withdrawn from issue under 37 CFR 1.313 by the Office of Petitions, which resulted in the Notice to applicant mailed February 17, 2000.

Due to the lateness of the request of the Director, the PTO could not prevent the previously scheduled publication of the specification in the February 29, 2000, Official Gazette. Nevertheless, as the Notice of February 17, 2000, indicated that this application had been withdrawn from issue, the patent did not issue on February 29, 2000. See Harley v. Lehman, 981 F. Supp. 9, 44 USPQ2d 1699 (D.D.C. 1997). As is usual in such instances, an erratum notice was published in the Official Gazette on March 14, 2000.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § 6(a) provides, in part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. § 131 states:

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

37 CFR 1.313 states that:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. Any such petition by the applicant must include a showing of good and sufficient reasons why withdrawal of the application is necessary and, if the reason for the withdrawal is not the fault of the Office, must be accompanied by the fee set forth in § 1.17(i). If the application is withdrawn from issue, a new notice of allowance will be sent if the application is again allowed. Any amendment accompanying a petition to withdraw an application from issue must comply with the requirements of § 1.312.

(b) When the issue fee has been paid, the application will not be withdrawn from issue for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims;
- (4) For interference; or
- (5) For abandonment to permit consideration of an information disclosure statement under § 1.97 in a continuing application.

MPEP 1201 states in pertinent part that:

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of

opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter.

OPINION

Petitioner asks that the Commissioner intervene and consider the instant petition. As to the merits of the petition, petitioner contends that the withdrawal from issue was a clear error as authorized by the Director of the Special Programs Law Office, and points to the communication addressed to the Director of Technology Center 1700 which accompanies the petition in support of his assertions. Petitioner's short letters to the Commissioner and Director Spar appear to rest on the theory that no new issue of patentability arose. As noted below, this argument is without merit. The letter to Director Kepplinger, which accompanied the two former letters, merely requests a meeting with PTO personnel to discuss the application that was withdrawn.²

The decision of the Director to request withdrawal from issue to reopen prosecution of this application did not constitute either the rejection of a claim or a decision adverse to the ultimate patentability of a claim. See In re Voss, 557 F.2d 812, 816, 194 USPQ 267, 270 (CCPA 1977). The PTO will issue in due course either a supplemental notice of allowance or an office action rejecting the claims. If the claims are rejected, Petitioner will then have a full opportunity to rebut the PTO's decision, including ultimately an appeal on the patentability merits to the Board of Patent Appeals and Interferences.

² In the time period between submission of the petition and this decision, petitioner has been offered an opportunity to provide whatever information it chooses to submit to the PTO at an on-the-record Office Interview. However, petitioner has refused to participate in such a meeting although such a meeting was requested by petitioner.

While it is understandable that petitioner is concerned about the withdrawal from issue of the above-identified application, the record does not show that the SPLO has acted beyond the scope of its authority in promptly assisting with the request from the Director to secure the withdrawal of this application from issue, or, based on that request, authorizing the Notice of February 17, 2000, for the Technology Center's purpose of reopening prosecution. Rather, that assistance is specifically within the SPLO's purview.

Section 1.313(b) of 37 CFR specifically authorizes the PTO to withdraw an application from issue to reopen prosecution. See Harley v. Lehman, 981 F. Supp. 9, 11-12, 44 USPQ2d 1699, 1701-02 (D.D.C. 1997) (applications may be withdrawn from issue even after payment of the issue fee in situations wherein the Group Director seeks to reopen prosecution). The withdrawal Notice of which petitioner complains merely apprised petitioner of the fact of withdrawal, and further, served the purpose of returning jurisdiction of the application to the Technology Center. See MPEP 1302.

In reaching her decision, the Director read the specification of the '935 patent and noted, *inter alia*, that the shrunken, lower energy hydrogen atoms or "hydrinos," are asserted in the '935 patent to react with other atoms, such as those of metals, to produce hydrides, which are the compounds claimed in the application at issue. The principles set forth in the '935 patent are not known to the Director to be generally recognized by the scientific community, but rather, are indicated in the '935 patent to be the discovery of one of the above-named inventors who asserted to have built further on quantum mechanics and derived a new atomic theory based on "first principles." The '935 patent further claims that its "novel theory . . . unifies Maxwell's Equations, Newton's Laws, and Einstein's General and Special Relativity."³

The concept that hydrinos can be created by hydrogen atoms relaxed to below their "ground state," was recognized by the Director not to conform with the known laws of chemistry and physics that are embraced by the scientific community. This lack of compliance with the known laws of chemistry and physics reasonably caused the Director to request withdrawal from issue of the instant application due to the Director's determination that one or more claims lacked patentability.

³ In its petition, petitioner refers to its invention as "revolutionary technology."

Furthermore, an inspection of Application No. 09/009,294 reveals that this invention is asserted to matters containing fractional quantum numbers. Such fractional quantum numbers do not conform to the known laws of physics and chemistry. For instance (1) page 5, lines 10-20, (2) page 11, lines 14-30, (3) page 68, lines 21-35, and (4) claim 17, all pertain to fractional quantum numbers which are not known to conform to the known laws of physics and chemistry.

The application did not issue as a patent on February 17, 2000, and thus, it did not enjoy the statutory presumption of validity, including operability, that is reserved only for an issued patent, when the Director requested withdrawal from issue. See 35 U.S.C. § 282. As such, the Director was not prohibited from determining anew that the technology embraced by the instant application lacked patentability of one or more claims.

That is, in light of (1) the application pertains to the field of chemistry (see title: "Hydride Compounds") which is often unpredictable, (2) the statement noted above by the Director which pertains to how these compounds are produced by a chemical reaction involving a hydrogen atom in a state that is not recognized by the scientific community which (3) the Director discerned was, on its face, contrary to generally accepted scientific principles, the reasonableness of the Director's decision to request withdrawal from issue to reopen prosecution is apparent. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369-370 (CCPA 1971):

In the field of chemistry generally, there may be times when the well-known unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put forward as enabling support for a claim. This will especially be the case where the statement is, on its face, contrary to generally accepted scientific principles.

See also In re Chilowsky, 229 F.2d 457, 462, 108 USPQ 321, 325 (CCPA 1956):

Thus, in the usual case where the mode of operation alleged can be readily understood and conforms to the known laws of physics and chemistry, operativeness is not questioned, and no further evidence is required. On the other hand, if the alleged operation seems clearly to conflict with a recognized scientific principle as, for example, where an applicant purports to have discovered a machine producing perpetual motion, the presumption of inoperativeness is so strong that very clear evidence is required to overcome it.

Further, while petitioner complains that the Notice of February 17, 2000, does not set forth any "new" issues of mistake, violation of 37 CFR 1.56, or unpatentability of one or more claims, in support of the withdrawal, 37 CFR 1.313 does not require the issue(s) be "new" for the Director's request for withdrawal from issue to be proper. Petitioner assumes that once a single PTO employee agrees with an applicant, even erroneously, no further review within the PTO is warranted or legally possible. Such a belief is without merit. For example, an examiner is not precluded from reopening prosecution to reinstate a rejection that had been made earlier in prosecution and withdrawn. See In re Freeman, 166 F.2d 178, 180, 76 USPQ 585, 586 (CCPA 1948).⁴ See also 37 CFR 1.196(b) (Board of Patent Appeals and Interferences may enter grounds of rejection not contained in the examiner's final rejection when applicant appeals final rejection).

While petitioner in the accompanying letter points to favorable testimonials from scientists and entrepreneurs regarding the "revolutionary technology" that the instant application is asserted to embody, this does not establish that either the Director, Technology Center 1700, or the Director, Special Programs Law Office, committed reversible error, nor that the Notice should be withdrawn. In contrast, mainstream newspapers have reported this same "revolutionary technology" is accompanied by controversy in the scientific community. See Baard et al., Scientists and entrepreneurs have lots of ideas about new sources of energy; some may even be practical, Wall St. J., Sept. 13, 1999, at R16; Park, Perpetual motion: still going around, Washington Post, Jan. 12, 2000, at H3.

The PTO has an obligation to issue patents that meet the statutory requirements for patentability. 35 U.S.C. § 131. See also In re Schmidt, 377 F.2d 639, 641, 153 USPQ 640, 642 (CCPA 1967); Markman v. Westview Instruments, Inc., 52 F.3d 967, 985

⁴ In Freeman, the reopening of prosecution set forth, *inter alia*, a ground of rejection (double patenting) that had been made earlier in prosecution, but had not been repeated in the final rejection, and, as such, was not an issue considered in the first appeal. After this rejection was affirmed by the Board of Appeals in the second appeal, counsel for Freeman argued unsuccessfully to the court that the circumstances suggested that this ground of rejection had not initially been repeated due to its "doubtful propriety." The CCPA noted that the rejection was nevertheless properly before it for consideration on the merits, and likewise affirmed. Id.

n.14, 34 USPQ2d 1321, 1334 n.14 (Fed. Cir. 1995), aff'd, 116 S. Ct. 1384, 38 USPQ2d 1461 (1996). It would be contrary to sound public policy for the PTO to issue a possibly invalid patent. See Harley, 44 USPQ2d at 1701. When, as here, a "revolutionary technology" has been reported in the public record as being viewed with skepticism by two physicists of repute (including the 1997 Nobel co-laureate in physics, see Baard et al.) and further, another professor of physics (see Park) publicly asserts that such "revolutionary technology" does not conform with the known laws of physics and chemistry, it is reasonable for the PTO to withhold issuance to ensure that all the statutory requirements for a patent have been herein met.

While petitioner points to U.S. Patent No. 6,024,935 recently issued to Mills, the law is well settled that the issuance of that patent cannot operate to discharge the PTO's obligation with respect to the patentability *vel non* of the instant application. See In re Margaroli, 318 F.2d 348, 138 USPQ 158 (CCPA 1963); In re Wright, 256 F.2d 583, 118 USPQ 287 (CCPA 1958); In re Launder, 212 F.2d 603, 101 USPQ 391 (1954). Rather, such issuance is immaterial to, and does not undermine, the reasonableness of the request of the Director to seek withdrawal from issue to permit reopening of prosecution, see In re Giolito, 530 F.2d 397, 188 USPQ 645 (CCPA 1976), or the reasonableness of the action of the SPLO in implementing that request.

This conclusion of reasonableness on the part of the PTO *vis-a-vis* patentability is reinforced by the controversy surrounding this allegedly "revolutionary technology." As the PTO examines applications which embrace almost every field of endeavor, it is reasonable for the PTO to take appropriate steps to satisfy itself in the first instance, especially when a controversial "revolutionary technology" is involved, that the statutory requirements pertaining to the issuance of patents have been met. See generally Newman v. Quigg, 877 F.2d 1575, 11 USPQ2d 1340 (Fed. Cir. 1989); Ex parte Dash, 27 USPQ2d 1481 (BPAI 1992).

DECISION

A review of the record indicates that the Director, Special Programs Law Office, and the Director, Technology Center 1700, did not act improperly in withdrawing the application from issue. For the foregoing reasons, the withdrawal of the application from issuance is appropriate.

As such, the Notice of February 17, 2000, will not be rescinded. The above-identified application remains withdrawn from issue. An Office Action addressing the merits of the application or a supplemental Notice of Allowance will issue in due course.

This decision, as with all petitionable procedural matters, does not relieve or suspend applicant's obligation to continue prosecuting the patent application. 37 CFR 1.181(f) ("The mere filing of a petition will not stay the period of reply to an Examiner's action which may be running against an application, nor does it act as a stay of other proceedings."). In this application, no time limit is currently pending against applicant.



Stephen G. Kunin
Deputy Assistant Commissioner for
Patent Policy and Projects